REMARKS

Claims 9-13 and 19-46 were pending in the Application. Claim 9 is an independent claim and claims 10-13 and 39-41 depend therefrom. Claim 19 is an independent claim and claims 20-26 and 42-46 depend therefrom. Claim 27 is an independent claim and claims 28-38 depend therefrom. Claims 1-8 and 14-18 were previously canceled. Claims 9-12, 19, 27-28, 30, 32, 39 and 41 are currently amended. The Applicant respectfully requests that the application be reconsidered in view of the amendments set forth above and the following remarks.

Rejections Under 35 U.S.C. §112, First Paragraph (Claims 9-13 and 19-46)

In points 8-9 on pages 2-4 of the Office Action, claims 9-13 and 19-46 were rejected under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement. Specifically, the Office Action alleges that with regard to recording all input information, the subject matter is not properly described in the application as filed, since the specification only discloses recording real-time information such as input data, input samples, and commands (*see paragraphs [21] and 31]*). As can be seen, input data, input samples, and commands are the only types of real-time information that are recorded." (Office Action, Page 4, Point 9). The Applicant notes, however, that the input data, input samples, and commands are also the only types of real-time information that are received. (*See e.g.*, Applicant's Figure 1). Thus, the Applicant's Specification clearly supports recording all input information. For example, the Applicant notes that the Applicant's specification explicitly teaches **fully** recording the information that is input to a real-time communication device. (*See e.g.*, Applicant's Specification, Paragraphs [11], [22] and [29]). In an effort to expedite allowance of the Applicant's claims, the Applicant has amended independent claims 9, 19 and 27 to recite "fully record input information." The Applicant notes that "fully record input information" is synonymous with "record all input information." Therefore, the Applicant notes that the amendment in no way alters the scope of the Applicant's claims. The Applicant respectfully submits that Applicant's claims 9-13 and 19-46 clearly comply with 35

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U.S.C. §112, first paragraph. Thus, the Applicant respectfully requests that the rejection of claims 9-13 and 19-46 under 35 U.S.C. §112, first paragraph, be withdrawn.

Rejections Under 35 U.S.C. §112, Second Paragraph (Claims 9-13 and 19-46)

In points 10-11 on pages 4-5 of the Office Action, claims 9-13 and 19-46 were rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office Action alleges that "[c]laims 9, 19, and 27 recite the limitation 'a period of time.' The term 'period' is a relative term, which renders the claims indefinite." (Office Action, Page 5, Point 11). The Applicant respectfully traverses the rejection, noting that the term "period" does not fall under the category of terms outlined in MPEP 2173.05(b). Further, the Applicant notes that 67,287 U.S. Patents contain the term "period of time" in their claims, 237 of those U.S. Patents issuing in the year 2010. In other words, the Office Action's interpretation of the term "period of time" is clearly erroneous and contrary to the position of the USPTO as a whole. Regardless, in an effort to expedite issuance of the claims, the Applicant has deleted the "over a period of time" limitation. Thus, the Applicant respectfully requests that the rejection of claims 9-13 and 19-46 under 35 U.S.C. §112, second paragraph, be withdrawn.

Rejections Under 35 U.S.C. §102(e) – Abdelilah (Claims 9-13 and 39-41)

In point 13 on pages 6-11 of the Office Action, independent claim 9 and dependent claims 11-13 and 39-41 were rejected under 35 U.S.C. §102(e) as being anticipated by Abdelilah et al. (U.S. Patent No. 6,823,004, hereinafter "Abdelilah"). Without conceding that Abdelilah qualifies as prior art under 35 U.S.C. §102(e), the Applicant respectfully traverses the rejections for at least the following reasons.

With regard to the anticipation rejections, MPEP 2131 states, "[a] claim is anticipated

only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 2 USPQ2d 1051, 1053 (Fed.Cir. 1987). MPEP 2131 also states, "[t]he identical invention must be shown in as complete detail as is contained in the … claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Regarding claim 9, the Applicant respectfully submits that Abdelilah fails to at least teach, suggest, or disclose, for example, "a recording module processor communicatively coupled to the first input and the second input that **operates to fully record input information arriving at one or both of the first input and the second input** during real-time operation of the modem device for subsequent non-real-time analysis," as set forth in Applicant's independent claim 9.

Abdelilah merely teaches using the DSP 340 to process and store in DSP memory 345: diagnostic data, data related to modem performance and internal state information (i.e., select data). (*See e.g.*, Abdelilah, Abstract; Column 4, Lines 62-64; Column 5, Lines 14 and 24-30; Column 8, Lines 16-19, 30-31 and 63-66; Column 9, Lines 1-4, 10-11 and 33-43; and Column 10, Lines 6-7). Nowhere in Abdelilah is there any disclosure regarding **fully recording** input information arriving at one or both of the first input and the second input. Rather, Abdelilah identifies the select data that may be obtained, for example, at Column 9, Lines 33-61. Thus, because Abdelilah merely discloses processing and storing **select data** related to diagnostics, performance and internal states, Abdelilah fails to disclose "a recording module processor communicatively coupled to the first input and the second input that **operates to fully record input information arriving at one or both of the first input and the second input** during real-time operation of the modem device for subsequent non-real-time analysis," as recited by the Applicant in independent claim 9. Because the Office Action has failed to show "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference" as required for an anticipation rejection under MPEP 2131, the rejection under 35 U.S.C. § 102(e) cannot be maintained.

The Response to Arguments section of the Office Action states the following:

Abdelilah clearly discloses "a recording module processor communicatively coupled to the first input and the second input that operates to cause all input information arriving over a period of time at one or both of the first input and the second input during real-time operation of the modem device to be recorded for subsequent non-real-time analysis"

(see Column 9: 66 and 67 to Column 10: 1-49, "...the teachings of the present invention are particularly directed to environments in which both a primary path and a secondary path are available to the DSP memory 345 to provide for monitoring operations to occur in real time while a communication connection is active through the modem. As is evident from **the types of information identified above which may be monitored** according to the present invention, **a significant amount of performance information can be tracked** during a communication connection, for example, on a minute-by-minute basis or responsive to detection of the occurrence of certain events. The monitoring system of the present invention may be utilized to monitor internal states of the modem 310 or state transitions of one or more state machines implemented within the modem 310 and to **selectively record specified parameters** out of the total set of parameters available within the DSP memory 345 during state conditions where the selected parameters are significant or of potential interest to a diagnostic user." and

"Information may be collected on a real time basis and recorded during the life of a connection. Furthermore, information about disconnects may be gathered and throughput for a connection can be estimated. In addition, data may also be collected when a connection is being attempted, in other words, during the startup phases before a connection is in use for data communication." and

"Furthermore, as performance information may be collected on a real-time basis during a connection, **pertinent data may be preserved** which might otherwise be lost as a result of an event causing diagnostic data in the DSP memory 345 to be overwritten (for example, during retrains). The performance data may be recorded while the user of the client modem 310 is actively connected to a remote server modem in a normal manner such as through a service provider end user application (e.g. AOL, IGN Dialer and Windows Dial-up Networking) executing on the host system 300. Performance data may be obtained throughout the active connection operations including both the startup phases and during data communication as well as the disconnect procedures.

Note that Abdelilah's invention is directed to monitoring the performance of a modem which may be able to obtain data in real-time. Abdelilah discloses that real-time modem performance data, internal states of the modem, modem communication data, and modem startup and disconnect data, etc. are recorded during the life of a connection of the modem. **Thus, one of ordinary skill in the**

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**art would readily comprehend that Abdelilah intends on _recording_ all the
relevant modem data that are needed in order to monitor the performance of
a modem.**

(Office Action, Pages 36-37, Examiner's Response (a) (emphasis added)). Clearly, as the cited sections of Abdelilah explicitly teach, Abdelilah does not fully record input information. Rather, Abdelilah merely teaches selectively recording specified parameters (i.e., certain types of information, pertinent data). Even the Examiner explicitly acknowledges that Abdelilah only records relevant modem data. Thus, Abdelilah unequivocally cannot teach "a recording module processor communicatively coupled to the first input and the second input that **operates to fully record input information arriving at one or both of the first input and the second input during real-time operation of the modem device** for subsequent non-real-time analysis," as set forth in Applicant's independent claim 9. Because the Office Action has failed to show "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference" as required for an anticipation rejection under MPEP 2131, the rejection under 35 U.S.C. § 102(e) cannot be maintained.

Therefore, for at least the above stated reasons, Applicant respectfully submits that the Abdelilah reference fails to teach, suggest, or disclose Applicant's invention as set forth in claim 9. The Applicant believes that claim 9 is allowable over Abdelilah. Applicant respectfully submits that claim 9 is an independent claim, and that claims 10-13 and 39-41 depend either directly or indirectly from independent claim 9. Because claims 10-13 and 39-41 depend from claim 9, Applicant respectfully submits that claims 10-13 and 39-41 are allowable over the Abdelilah reference, as well. The Applicant further submits that each of claims 10-13 and 39-41 is independently allowable. The Applicant respectfully requests, therefore, that the rejection of claims 9-13 and 39-41 under U.S.C. §102(e), be withdrawn.

Rejections Under 35 U.S.C. §103(a) – Abdelilah and Kaler (Claims 19-38, 42-44 and 46)

In point 15 on pages 11-34 of the Office Action, independent claims 19 and 27, and

dependent claims 20-26, 28-38, 42-44 and 46 were rejected under 35 U.S.C. §103(a) as being unpatentable over Abdelilah in view of Kaler et al. (U.S. Patent No. 6,467,052, hereinafter "Kaler"). The Applicant respectfully traverses the rejection for at least the following reasons.

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure, Rev. 6, Sep. 2007 ("MPEP") states the following:

> The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" (citing *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007)). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness:

> The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

Regarding claim 19, Applicant respectfully submits that the combination of Abdelilah and Kaler at least fails to teach, suggest, or disclose at least, for example, "wherein the recording module **fully records the input information received at the modem** during real-time operation of the modem," as set forth in Applicant's independent claim 19.

As mentioned above with regard to Applicant's independent claim 9, Abdelilah fails to disclose "wherein the recording module **fully records the input information received at the modem** during real-time operation of the modem," as set forth in Applicant's independent claim 19. Abdelilah merely teaches using the DSP 340 to process and store in DSP memory 345: diagnostic data, data related to modem performance and internal state information (i.e., select data). (*See e.g.*, Abdelilah, Abstract; Column 4, Lines 62-64; Column 5, Lines 14 and 24-30; Column 8, Lines 16-19, 30-31 and 63-66; Column 9, Lines 1-4, 10-11 and 33-43; and Column 10, Lines 6-7). Nowhere in Abdelilah is there any disclosure regarding **fully recording** input information received at the modem. Rather, Abdelilah identifies the select data that may be obtained, for example, at Column 9, Lines 33-61. Thus, because Abdelilah merely discloses processing and storing **select data** related to diagnostics, performance and internal states, Abdelilah fails to disclose "wherein the recording module **fully records the input information received at the modem** during real-time operation of the modem," as set forth in Applicant's independent claim 19. Kaler fails to remedy the deficiencies of Abdelilah. Thus, because the combination of Abdelilah in view of Kaler fails to teach the limitations of Applicant's independent claim 19, the rejection under 35 U.S.C. § 103(a) cannot be maintained.

Therefore, for at least the above stated reasons, Applicant respectfully submits that Applicant's claim 19 is allowable over the combination of Abdelilah and Kaler. Applicant respectfully submits that claim 19 is an independent claim, and that claims 20-26 and 42-46 depend either directly or indirectly from independent claim 19. Because claims 20-26 and 42-46 depend from claim 19, Applicant respectfully submits that claims 20-26 and 42-46 are allowable over the combination of Abdelilah and Kaler, as well. The Applicant further submits that each of claims 20-26 and 42-46 is independently allowable. The Applicant respectfully requests, therefore, that the rejections of claims 19-26, 42-44 and 46 under U.S.C. §103(a), be withdrawn.

Turning next to claim 27, Applicant respectfully submits that the combination of Abdelilah and Kaler at least fails to teach, suggest, or disclose at least, for example, "while operating the modem in real-time, utilizing the recording module to **fully record input information input to**

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at least the first and/or second inputs of the modem," as set forth in Applicant's independent claim 27.

As mentioned above with regard to Applicant's independent claims 9 and 19, Abdelilah fails to disclose "while operating the modem in real-time, utilizing the recording module to **fully record input information input to at least the first and/or second inputs of the modem,**" as set forth in Applicant's independent claim 19. Abdelilah merely teaches using the DSP 340 to process and store in DSP memory 345: diagnostic data, data related to modem performance and internal state information (i.e., select data). (*See e.g.,* Abdelilah, Abstract; Column 4, Lines 62-64; Column 5, Lines 14 and 24-30; Column 8, Lines 16-19, 30-31 and 63-66; Column 9, Lines 1-4, 10-11 and 33-43; and Column 10, Lines 6-7). Nowhere in Abdelilah is there any disclosure regarding **fully recording** input information input to at least the first and/or second inputs of the modem. Rather, Abdelilah identifies the select data that may be obtained, for example, at Column 9, Lines 33-61. Thus, because Abdelilah merely discloses processing and storing **select data** related to diagnostics, performance and internal states, Abdelilah fails to disclose "while operating the modem in real-time, utilizing the recording module to **fully record input information input to at least the first and/or second inputs of the modem,**" as set forth in Applicant's independent claim 27. Kaler fails to remedy the deficiencies of Abdelilah. Thus, because the combination of Abdelilah in view of Kaler fails to teach the limitations of Applicant's independent claim 27, the rejection under 35 U.S.C. § 103(a) cannot be maintained.

Therefore, for at least the above stated reasons, Applicant respectfully submits that Applicant's claim 27 is allowable over the combination of Abdelilah and Kaler. Applicant respectfully submits that claim 27 is an independent claim, and that claims 28-38 depend either directly or indirectly from independent claim 27. Because claims 28-38 depend from claim 27, Applicant respectfully submits that claims 28-38 are allowable over the combination of Abdelilah and Kaler, as well. The Applicant further submits that each of claims 28-38 is independently allowable. The Applicant respectfully requests, therefore, that the rejections of claims 27-38 under U.S.C. §103(a), be withdrawn.

Rejections Under 35 U.S.C. § 103(a) – Abdelilah, Kaler and Read (Claim 45)

In point 16 on pages 34-35 of the Office Action, claim 45 was rejected under 35 U.S.C. §103(a) as being unpatentable over Abdelilah in view of Kaler and further in view of Read et al. (U.S. Patent No. 5,353,243, hereinafter "Read"). The Applicant respectfully submits that claim 45 depends either directly or indirectly from independent claim 19. Applicant believes that claim 19 is allowable over the proposed combination of references, in that Read fails to overcome the deficiencies of Abdelilah in view of Kaler, as set forth above. Because claim 45 depends from independent claim 19, Applicant respectfully submits that claim 45 is allowable over the proposed combination of Abdelilah, Kaler and Read, as well. Applicant also asserts that claim 45 is independently allowable. Therefore, for at least the reasons set forth above, Applicant respectfully requests that the rejection of claim 45 under 35 U.S.C. §103(a) be withdrawn.

Final Matters

The Office Action makes various statements regarding claims 9-13 and 19-46, 35 U.S.C. § 112, First Paragraph, 35 U.S.C. § 112, Second Paragraph, 35 U.S.C. § 102(e), 35 U.S.C. § 103(a), the Abdelilah reference, the Kaler reference, the Read reference, one of ordinary skill in the art, etc. that are now moot in view of the above amendments and/or arguments. Thus, the Applicant will not address all of such statements at the present time. However, the Applicant expressly reserves the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

Applicant reserves the right to argue additional reasons supporting the allowability of claims 9-13 and 19-46 should the need arise in the future.

CONCLUSION

Applicant respectfully submits that claims 9-13 and 19-46 are in condition for allowance, and requests that the application be passed to issue.

Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the telephone number listed below.

Please charge any required fees not paid herewith or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Date: January 27, 2010   Respectfully submitted,

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